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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 054103/0101

In re Reissue Application of

Satoshi KONO *et al*

Group Art Unit: 3682

U.S. Patent No: 5,465,635

Examiner: V. Luong

Reissue Serial No: 08/629,547

Reissue Filed: April 9, 1996

For: FLYWHEEL ASSEMBLY FOR INTERNAL COMBUSTION ENGINE (as revised)



**REPLY BRIEF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This Reply Brief is being filed in reply to the Examiner's Answer mailed on May 22, 2002, and is directed to new points of argument or clarification in the Examiner's Answer.

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**NEW POINTS OF ARGUMENT**

The Examiner's Answer is believed to raise the following new points of argument or clarification of arguments made in the Final Rejection:

1. The Examiner's Answer makes a factual misstatement with regard to claims 16 and 18 of the grandparent application that is important to the issue of whether Appellants "surrendered" the subject matter of flange 4b.

2. The Examiner's Answer clarifies what the PTO considers as constituting "surrender," thereby making evident that the PTO's rejection is based on legal error regarding the issue of "surrender."

3. The Examiner's Answer contradicts the Final Rejection at the very heart of

the PTO's argument that the narrowing limitation, added in the reissue claims vis-à-vis the amended/cancelled claims leading up to the original patent, is not "related," "material" or "germane" to the rejection of the amended/canceled claims in the grandparent application.

4. The PTO has for the first time relied specifically on Example 4(a) of the Reissue Guidelines as a basis for refusing Appellants' claims.

### ARGUMENT

#### **I. Misstatement with regard to claims 16 and 18 of the grandparent application**

On page 5 of the Examiner's Answer, the PTO makes the following statement:

"Claims 16 and 18 [of Appellants' grandparent application Serial No. 485,659] call for a reinforcing member 4 *that has the flange 4b*. Claims 16 and 18 in turn were rejected by the Board decision on January 5, 1994. Appellants canceled claims 16 and 18 in SN '659 in order to obtain the issued Patent No. 5,465,635. Therefore, appellants surrendered the reinforcing member 4 which includes the flange 4b claim in claims 16 and 18 of SN "659" (Emphasis added)

Appellants attach hereto a copy of claims 16 and 18 as reprinted in the Board opinion in grandparent application Serial No. 485,659, from which it can be seen that neither claim 16 nor claim 18 recites any structure defining flange 4b. Moreover, to the extent that any structure of the reinforcing member is set forth in claim 16 or claim 18, the claim language characterizes the reinforcing member as "defining a space between said elastic plate and said flywheel," i.e., the "first clearance" between the flywheel and the elastic plate, as recited in claims 113 and 128 on appeal and not the "first free space" that is defined on the opposite side of the flywheel. Consequently, the prosecution of claims 16 and 18 in the grandparent application does not provide any basis whatsoever for concluding that Appellants "surrendered" the subject matter of flange 4b. Appellants continue to strongly urge that there is no evidence in any of the prosecution leading up to issuance of original '635 patent that Appellants "surrendered" the flange 4b to gain allowance of the original patent.

## II. The PTO's rejection is based on legal error regarding the issue of "surrender."

The Examiner's Answer clarifies what the PTO considers as constituting "surrender," thereby making evident that the PTO's rejection flows from a fundamentally incorrect legal premise regarding the issue of "surrender."

At the middle of page 4 of the Examiner's Answer, Appellants' explanation in the Appeal Brief that the threshold issue of surrender focuses on the subject matter that has been eliminated from the claims of the original patent is said to "lack proper legal foundation." The Board need only refer to the explanation of the TWO STEP TEST FOR RECAPTURE beginning at the bottom of page 1 of the Reissue Guidelines (quoting *In re Clement*) to understand that the PTO in the present case is not applying the proper analysis that is clearly set forth in the case law as well as in the very Guidelines that the PTO purports to apply in rejecting the present application.

At the bottom of page 3 and again in the middle of page 4, the Examiner's Answer points out that "appellants' statement that if there is no broadening of surrendered subject matter, there can be no recapture is incorrect" and suggests that "in the case there is nothing eliminated from the claims of the original patent" there can still be recapture. This statement of the law is clearly incorrect. If there is nothing eliminated from the original patent claims in a reissue application, then the reissue is not a broadening reissue. The doctrine of recapture has no application to reissues that do not broaden the original patent claims. See page 4 of Reissue Guidelines. The Reissue Guidelines make it clear that reissue recapture is applicable only to broadened subject matter vis-à-vis the original patent claims and furthermore only with respect to broadened subject matter that is "surrendered" subject matter. If there is no broadening of "surrendered" subject matter, there can be no violation of the recapture rule.

In response to Appellants' arguments regarding "surrender" as a threshold issue, the PTO responds in Section C on page 4 of the Answer by stating that the "[proper] test is 'whether the reissue claims are the *same* or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.'" Of course, this "test" recited in the Examiner's Answer is the test that applies after it is determined that

“surrendered” subject matter has been eliminated from a reissue claim, i.e., to determine whether impermissible or permissible recapture has taken place. This test does not inform the threshold inquiry as to whether any subject matter has been surrendered in the first place. Instead, to determine whether there has been surrender “of particular subject matter,” the Federal Circuit has said “we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” See Reissue Guidelines, bridging pages 1 and 2.

Thus, the PTO’s clarification of its understanding as regards that which constitutes “surrender” demonstrates a fundamental legal error in making the present rejection. In the present application, the “particular subject matter” to which the Federal Circuit refers in describing the proper analysis is flange 4b, i.e., the only subject matter broadened vis-à-vis the claims of the original patent claims. Neither the Final Rejection nor the Examiner’s Answer points to any concrete indication in the prosecution history that Appellants intended to “surrender” the subject matter of flange 4b. Flange 4b was never argued as a basis for patentability, but rather only the “clearance” (free space) that was defined in the original claims with reference to flange 4b. This fact stands uncontroverted in the present record.

### **III. The Examiner’s Answer contradicts an essential basis for the rejection set forth in the Final Rejection.**

It has been Appellants’ consistent position in their Appeal Brief that flange 4b was never “surrendered” and therefore that the essential threshold requirement for recapture is completely lacking in this case. Appellants then pointed out, *arguendo*, that even if flange 4b were to be considered as “surrendered,” no impermissible recapture has taken place because the canceled claims (e.g., claims 16 and 18) have been narrowed by the addition of material limitations that are directly germane to the rejection over Numata.

The Examiner’s Answer contradicts the Final Rejection at the very heart of the PTO’s argument that the narrowing limitations, added in the reissue claims vis-à-vis the amended/cancelled claims leading up to the original patent, are not “germane,” “material” or “relevant” to the prior art rejection based on Numata that was overcome to achieve the

grant of original U.S. Patent No. 5,465,635. In the Final Rejection, at pages 5-6, the PTO states as follows:

“In the instant case, claims 113 and 128 copy claims 16 and 18 of SN ‘659 and add new limitations in the “wherein” clauses. The first “wherein” clause which recites that “said elastic plate is clamped axially between said reinforcing member and said shaft end of said crankshaft” is copied from claim 4 of Pat. ‘635. The second “wherein” clause which recites that “said first portion of said flywheel body and said elastic plate defining a first clearance and said flywheel body having a first free space on a side opposite of the first clearance for allowing said first portion of said flywheel body to move axially within the first clearance and the free space” merely states inherent result of limitations already recited in the body of the claim, thus, it adds nothing to claim’s patentability or substance. [cite omitted] Since the added limitations are merely “*incidentally*” or “*inherent*,” they should not be considered as “material.” [cite omitted]

Of course, these arguments in the Final Rejection (which are essential to the rejection) stand in contradiction to the fact that substantially these same limitations (i.e., the order of the three members and the axial movement of the flywheel within the two clearances or spaces) were added to the subject matter of claims 16 and 18 of the grandparent application and were argued and accepted by the PTO as patentably distinguishing the invention over the same Numata reference over which claims 16 and 18 were rejected, i.e., thereby leading to allowance of the original ‘635 patent. For the Board’s reference, a comparison has been included in Exhibit C attached to Appellants’ Appeal Brief of the single “wherein” clause of original patent claims 1 and 8 (representing the subject matter added to rejected claims 16 and 18 of the grandparent) and the four “wherein” clauses in reissue claims 113 and 128 that replaced the single “wherein” clause of the original patent claims.

In the Examiner’s Answer, significantly, the PTO no longer denies that the four newly added “wherein” clauses in the reissue claims are “material” or “germane” to the rejection of grandparent claims 16 and 18 over Numata, but rather the PTO states that Appellants “do not define the *nexus* between the material respects and the prior art rejection.” (Examiner’s Answer, page 5, last sentence) Even if this were true (which it is not, inasmuch as Appellants’ Brief on pages 21-22 explains the *nexus* in detail), the PTO itself on page 7 of the Examiner’s Answer acknowledges the materiality of the subject matter of the four “wherein” clauses, by noting that “without adding of the ‘wherein’ clause in claim 1 of Patent No. 5,465,635, the examiner would maintain the rejections made by the Board based on Numata.” As the Board can see from Exhibit C of Appellants’

Appeal Brief, with the exception of the deletion of flange 4b, the four “wherein” clauses of reissue claims 113 and 128 are substantively nearly identical to the single “wherein” clause of original patent claim 1, which the PTO acknowledges was the basis for patentably distinguishing over Numata. Thus, Appellants respectfully submit that the PTO has fatally undercut its fundamental basis for alleging that there is impermissible recapture in the present reissue application.

#### **IV. The PTO has for the first time relied specifically on Example 4(a) of the Reissue Guidelines.**

The PTO has for the first time relied specifically on Example 4(a) of the Reissue Guidelines as a basis for refusing Appellants’ claims. Appellants will not repeat Example 4(a) in its entirety, but rather refer the Board to pages 10-11 of the Reissue Guidelines attached as Exhibit D to their Appeal Brief. In Example 4(a), the reissue claims eliminated the sole limitation (“orange peels”) that was added by amendment and argued to patentably distinguish the original patent claims over the prior art and included the new limitation that the originally recited “peppers” be “diced green bell peppers.” Impermissible recapture was found in Example 4(a) because “surrendered” subject matter was eliminated and the newly added limitation “is not at all related to the ‘orange peels’ and the manner in which it defined over the art.”

The present situation differs in several material respects from Example 4(a). First, flange 4b (the only eliminated element from the original patent claim) was only one of several limitations added to the rejected/cancelled claim. Second, flange 4b was never argued as distinguishing over the prior art Numata reference, and there is no indication that the PTO relied upon flange 4b in allowing the original patent, i.e., flange 4b was not “surrendered” during prosecution of the original patent in the present case. Third, the “added limitations” in the present reissue claims (vis-à-vis the rejected/canceled claims) pertain to the placement order of the elastic plate, flywheel and reinforcing member plus the axial movement of the flywheel within a first clearance and a first free space defined on opposite sides of the flywheel. These are essentially the same structural limitations that were added to the rejected/canceled claims of the grandparent application, and argued, to

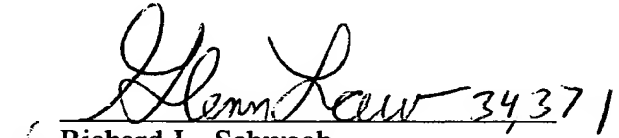
gain allowance of the original patent, i.e., the only difference between the subject matter added during prosecution of the original patent and that added to the reissue claims is the absence of flange 4b in the reissue claims. Consequently, the facts of Example 4(a) of the Reissue Guidelines bear no resemblance to the facts of the present case, and for this reason, Example 4(a) provides no support for the recapture rejection made in the present application.

## V. Conclusions

Accordingly, Appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of claims 113-165 based on reissue recapture.

Respectfully submitted,

July 22, 2002  
Date

  
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This Appeal Brief is being filed in triplicate. If any fee is due, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 19-0741.

16. A flywheel for a power transmission system for transmitting engine torque to a driven unit, comprising:  
an elastic plate secured to a crankshaft to rotate therewith; and

a flywheel body secured to said elastic plate and having an engageable surface which is engageable with a clutch disc;

a reinforcing member for reinforcing said elastic plate at a portion of said elastic plate which is secured to said crankshaft, said reinforcing member defining a space between said elastic plate and said flywheel body,

said elastic plate having an axial rigidity in the range of 600 kg/mm to 2200 kg/mm so as to ensure transmission of engine torque to said driven unit, while decreasing noise produced by a bending vibration of said crankshaft.

18. A flywheel for a power transmission system for transmitting engine torque to a driven unit, comprising:  
an elastic plate secured to a crankshaft to rotate therewith;

a flywheel body secured to said elastic plate and having an engageable surface which is engageable with a clutch disc; and



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a reinforcing member for reinforcing said elastic plate at a portion of said elastic plate which is secured to said crankshaft, said reinforcing member defining a space between said elastic plate and said flywheel body,

said engageable surface having an axial run-out which is equal to or less than 0.1 mm for ensuring a smooth engagement with said clutch disc.